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Dated: September 21 2004

Signature:

(Marco Jimenez)

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SEP 29 2004

OFFICE OF PETITIONS

Docket No.: 393032023900

Client reference: PA0009US (H7450US)  
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Taro TOKUHIRO et al.

Application No.: 09/824,483

Confirmation No.: 1512

Filed: March 30, 2001

Art Unit: 3625/Examiner M. Fadok

For: METHOD FOR SELLING ITEMS USING A  
NETWORK

Petition Examiner: ~~RECEIVED~~ Ian J. Lobo

OCT 1 8 2004

LICENSING UNIT

SUPPLEMENTAL DECLARATION OF SHIGEHICO MIZUNO

Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

I, Shigehiko Mizuno, declare as follows:

1. I currently reside in Hamamatsu, Japan.
2. I am an assistant manager in the Patent Liaison Department of the Pro Audio and Digital Musical Instruments Division of Yamaha Corporation ("Yamaha").
3. Yamaha is the assignee of a pending U.S. patent application entitled "Method For Selling Items Using A Network." The application was filed on March 30, 2001 and bears application no. 09/824,483. With the filing of the application on March 30, Yamaha's counsel

submitted a Petition for Retroactive License ("Petition."). The Petition included my declaration dated March 29, 2001 ("Declaration").

4. On July 9, 2001, the United States Patent and Trademark Office ("USPTO") granted a retroactive license bearing no. 527,180 in response to the Petition.

5. Although the Petition was reviewed and a license granted, I now understand that the USPTO has re-reviewed the Petition and has denied it. The denial of the Petition is based on 37 C.F.R. § 5.25(a)(3)(iii) which requires "an explanation of why the material was filed abroad through error and without deceptive intent with the required license under § 5.11 first having been obtained." This supplemental declaration, along with my original Declaration, are provided for the showing required under § 5.25(a)(3)(iii).

6. As I explained in my Declaration at paragraph 12, I was responsible for the filing of the application in Japan on December 28, 2000. I directed an outside patent attorney's office to file the application in Japan, because I assumed that Japan was the correct place to first file the application. I was unaware of any potential foreign filing licensing requirements at the time. Thus, the initial decision to file in Japan was in error and without deceptive intent.

7. I became aware of possible foreign filing licensing requirements for inventions made in the United States only after the application was filed in Japan. I believe I became aware of the possible foreign filing licensing requirements around February 2001. I was initially uncertain if a retroactive license was necessary given that the inventors worked on the invention in Japan and the United States. Moreover, I proceeded with foreign filings in other countries in addition to Japan, because I believed that such later filings would be covered by any retroactive license subsequently obtained for the earlier Japanese filing. Because of the Japanese filing, it did not occur to me that the additional filings should be halted until a retroactive license was obtained. Thus, I requested, in error and without deceptive intent, that the application be filed under the European Patent Convention and in Korea, Singapore and China.

8. I further declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and that these statements were made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Dated: September 21, 2004

Shigehiko Mizuno  
Shigehiko Mizuno